

ESTTA Tracking number: **ESTTA777561**

Filing date: **10/18/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91214933
Party	Plaintiff Alfredo Romo Dimas
Correspondence Address	STEVEN J EYRE LAW OFFICE 3550 WILSHIRE BLVD, STE 1440 LOS ANGELES, CA 90010 UNITED STATES stevenjeyre@gmail.com
Submission	Other Motions/Papers
Filer's Name	Steven J. Eyre
Filer's e-mail	stevenjeyre@gmail.com
Signature	/stevenjeyre/
Date	10/18/2016
Attachments	2016-10-18-Notice of Determination.pdf(373458 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Alfredo Romo Dimas, Individual Opposer, vs. Favian Tapia and Delia Tapia, Applicants.	Opposition No. 91214933 (Parent) In the Matter of Ser. No. 85771636
Alfredo Romo Dimas, Individual Petitioner, vs. Favian Tapia Matilde, Individual Respondent.	Cancellation No. 92057596 In the Matter of Reg. No. 3,797,278

NOTICE OF DETERMINATION OF ACTION

To the Board:

Please take notice that on October 1, 2015, the United States Federal District Court for the Central District of California in the case of Romo Dimas vs. Tapia Matilde, USDC CDCA Case No. CV 13-08840 DDP (ASx), entered Judgment and Permanent Injunction against Favian Tapia and Delia Tapia, Applicants in the Opposition Proceeding herein, and Favian Tapia Matilde, Respondent in the Cancellation Proceeding herein, by which:

1. Registration No. 3,797,278 of the trademark EL ROMANTICO SAMURAY was ordered cancelled;

2. Favia Tapia Matilde and Delia Tapia were permanently enjoined and restrained from using the service mark SAMURAY, or any confusingly similar or colorable imitation of the

mark, including without limitation the term EL ROMANTICO SAMURAY, in any manner in connection with the sale, advertising, offering, announcing or promotion of musical services, such as live performances of a musical group, or products, such as phonograph records, CDs, DVDs or their digital counterparts.

A true and correct copy of the Judgment and Permanent Injunction in the above-referenced action is attached hereto as **Exhibit A**.

The clerk of the court was ordered to give the USPTO notice of the court's order. Through inadvertence on the part of counsel for Opposer/Petitioner, form AO 120, Report on the Filing or Determination of An Action Regarding a Patent or Trademark, that was originally filed in the above-referenced federal action included the correct case number and other information but included an incorrect caption from a different federal case. A true and correct copy of the incorrect form AO 120 inadvertently filed at the outset of the above-referenced action is attached hereto as **Exhibit B**. A true and correct copy of form AO 120 with the incorrect caption sent by the clerk at the conclusion of the above-referenced action is attached hereto as **Exhibit C** and includes a copy of the Judgment and Permanent Injunction as an attachment.

Should the Board require, Opposer/Petitioner Alfredo Romo Dimas is willing to request that a corrected AO 120 be issued by the clerk of the court. However, if the attached documentation is sufficient to satisfy the Board as to the outcome of the above-referenced federal action, Opposer/Petitioner Alfredo Romo Dimas respectfully requests that the Board rule in Opposer/Petitioner's favor with respect to the relief requested in the Opposition and related Petition for Cancellation herein.

WHEREFORE, Petitioner hereby respectfully requests that the Board take the following actions:

A. That the cancellation requested by Opposer/Petitioner in Cancellation No. 92057596 for cancellation of Reg. No. 3,797,278 for the mark EL ROMANTICO SAMURAY be

entered in favor of Opposer/Petitioner Alfredo Romo Dimas in accordance with the Judgment and Permanent Injunction entered by the United States District Court for the Central District of California on October 1, 2015.

B. That Opposition Proceeding No. 91214933 be sustained in favor of Opposer/Petitioner Alfredo Romo Dimas and that application Ser No. 85771636 to register the mark EL ROMANTICO SAMURAY be dismissed with prejudice.

Alternatively, if the Board is unable to grant the foregoing relief based upon the attached evidence, Opposer/Petitioner respectfully requests that the Board notify Opposer/Petitioner of the documentation it requires to grant the foregoing relief.

Dated: October 18, 2016

Respectfully submitted

Alfredo Romo Dimas, an Individual
Petitioner

/stevenjeyre/
Steven J. Eyre
Attorney for Petitioner
Steven J. Eyre, Attorney at Law
3550 Wilshire Blvd., Ste 420
Los Angeles, CA 90010
Tel. 213.385.6926
Fax. 213.385.3313
Email: stevenjeyre@gmail.com

Exhibit A

JS-6

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

ALFREDO ROMO DIMAS, IGNACIO
ROMO DIMAS, JUAN LUIS ROMO
DIMAS, ROGELIO ROMO DIMAS,
GUILLERMO ROMO DIMAS,
GILBERTO ROMO DIMAS,

Plaintiffs,

-VS.-

FAVIAN TAPIA MATILDE, DELIA
TAPIA,

Defendants.

No. CV 13-08840 DDP (ASx)

JUDGMENT AND PERMANENT
INJUNCTION

The Court having granted the Motion for Summary Judgment of Plaintiffs
Alfredo Romo Dimas, Ignacio Romo Dimas, Juan Luis Romo Dimas, Rogelio
Romo Dimas, Guillermo Romo Dimas and Gilberto Romo Dimas,

IT IS HEREBY ORDERED, ADJUDGED AND DECREED as follows:

I. JUDGMENT

1. Judgment is hereby entered against Defendants Favian Tapia Matilde

1 and Delia Tapia in favor of Plaintiffs Alfredo Romo Dimas, Ignacio Romo Dimas,
 2 Juan Luis Romo Dimas, Rogelio Romo Dimas, Guillermo Romo Dimas, Gilberto
 3 Romo Dimas on Plaintiffs' claims of federal trademark infringement and
 4 cancellation of Defendants' trademark registration.

5 II. CANCELLATION OF REGISTRATION

6 2. It is ordered, adjudged and decreed that Registration No. 3,797,278 of
 7 the trademark EL ROMANTICO SAMURAY before the United States Patent and
 8 Trademark Office be, and hereby is, cancelled. The Clerk shall notify the United
 9 States Patent and Trademark Office of the Court's order.

10 III. PERMANENT INJUNCTION

11 3. Defendants Favian Tapia Matilde, Delia Tapia and their respective
 12 officers, agents, servants, employees, and attorneys, and any other persons who are
 13 in active concert or participation with any of the aforementioned persons who
 14 receive actual notice of this Judgment of Permanent Injunction by personal service
 15 or otherwise are hereby permanently ENJOINED and RESTRAINED from using
 16 the service mark SAMURAY, or any confusingly similar or colorable imitation of
 17 the mark, including without limitation the term EL ROMANTICO SAMURAY, in
 18 any manner in connection with the sale, advertising, offering, announcing or
 19 promotion of musical services, such as live performances of a musical group, or
 20 products, such as phonograph records, CDs, DVDs or their digital counterparts.

21 IV. IMPOUNDMENT AND DESTRUCTION

22 4. Defendants Favian Tapia Matilde, Delia Tapia and their respective
 23 officers, agents, servants, employees, and all persons in active concert or
 24 participation with Defendants who receive actual notice of this order by personal
 25 service or otherwise, are hereby ordered to remove and destroy all promotional
 26 literature, advertising, goods and other materials relating to the use of the term
 27 SAMURAY or EL ROMANTICO SAMURAY on or in connection with such
 28 advertising, goods or other materials within seven (7) days following receipt of such

1 actual notice of this order, and to provide plaintiff's counsel with evidence of such
2 removal and destruction within the same seven (7) day period following receipt of
3 such actual notice.

4 5. Violation of the permanent injunction herein by any person enjoined
5 herein shall constitute contempt of court, and plaintiffs may seek to recover
6 reasonable attorney's fees and costs expended in bringing a contempt motion.

7 IV. FEES, COSTS AND RETENTION OF JURISDICTON

8 6. The Court declines to award attorney's fees to Plaintiffs.

9 7. Plaintiff is awarded costs of suit in an amount to be determined by the
10 Clerk of the Court.

11 8. The Court shall retain jurisdiction to enforce the permanent injunction
12 included in this judgment.

13 9. Plaintiff is hereby authorized to engage in post-judgment discovery as
14 necessary to ensure compliance with the Court's Judgment and Permanent
15 Injunction.

16 IT IS SO ORDERED.

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18 Dated: October 01, 2015



19
20 HON. DEAN D. PREGERSON
21 UNITED STATES DISTRICT JUDGE
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Exhibit B

AO 120 (Rev. 08/10)

TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court CENTRAL DISTRICT OF CALIFORNIA on the following

☒ Trademarks or ☐ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO. CV 13-08840	DATE FILED 11/27/2013	U.S. DISTRICT COURT CENTRAL DISTRICT OF CALIFORNIA
PLAINTIFF AGUST RAMIREZ, ANTHONY RAMIREZ, AGUSTIN RAMIREZ, JR.		DEFENDANT MARIO SOTELO, RICARDO TARAZON, ARTURO BELTRAN, JORGE GUZMAN, JUAN ANTONIO SOTELO, DOES 1-10
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 3,797,278	6/1/2010	FAVIAN TAPIA MATILDE
2 4,229,726	10/23/2012	ALFREDO ROMO DIMAS
3		
4		
5		

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

Exhibit C

AO 120 (Rev. 08/10)

TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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1		
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5		

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT <p style="text-align: center;">10/11/15 JUDGMENT AND PERMANENT INJUNCTION</p>

CLERK Kiry Gray	(BY) DEPUTY CLERK L Chai	DATE 10/1/15
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Copy 1—Upon initiation of action, mail this copy to Director ^X Copy 3—Upon termination of action, mail this copy to Director
 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

JS-6

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

ALFREDO ROMO DIMAS, IGNACIO
ROMO DIMAS, JUAN LUIS ROMO
DIMAS, ROGELIO ROMO DIMAS,
GUILLERMO ROMO DIMAS,
GILBERTO ROMO DIMAS,

Plaintiffs,

-VS.-

FAVIAN TAPIA MATILDE, DELIA
TAPIA,

Defendants.

No. CV 13-08840 DDP (ASx)

JUDGMENT AND PERMANENT
INJUNCTION

The Court having granted the Motion for Summary Judgment of Plaintiffs
Alfredo Romo Dimas, Ignacio Romo Dimas, Juan Luis Romo Dimas, Rogelio
Romo Dimas, Guillermo Romo Dimas and Gilberto Romo Dimas,

IT IS HEREBY ORDERED, ADJUDGED AND DECREED as follows:

I. JUDGMENT

1. Judgment is hereby entered against Defendants Favian Tapia Matilde

1 and Delia Tapia in favor of Plaintiffs Alfredo Romo Dimas, Ignacio Romo Dimas,
2 Juan Luis Romo Dimas, Rogelio Romo Dimas, Guillermo Romo Dimas, Gilberto
3 Romo Dimas on Plaintiffs' claims of federal trademark infringement and
4 cancellation of Defendants' trademark registration.

5 **II. CANCELLATION OF REGISTRATION**

6 2. It is ordered, adjudged and decreed that Registration No. 3,797,278 of
7 the trademark EL ROMANTICO SAMURAY before the United States Patent and
8 Trademark Office be, and hereby is, cancelled. The Clerk shall notify the United
9 States Patent and Trademark Office of the Court's order.

10 **III. PERMANENT INJUNCTION**

11 3. Defendants Favian Tapia Matilde, Delia Tapia and their respective
12 officers, agents, servants, employees, and attorneys, and any other persons who are
13 in active concert or participation with any of the aforementioned persons who
14 receive actual notice of this Judgment of Permanent Injunction by personal service
15 or otherwise are hereby permanently ENJOINED and RESTRAINED from using
16 the service mark SAMURAY, or any confusingly similar or colorable imitation of
17 the mark, including without limitation the term EL ROMANTICO SAMURAY, in
18 any manner in connection with the sale, advertising, offering, announcing or
19 promotion of musical services, such as live performances of a musical group, or
20 products, such as phonograph records, CDs, DVDs or their digital counterparts.

21 **IV. IMPOUNDMENT AND DESTRUCTION**

22 4. Defendants Favian Tapia Matilde, Delia Tapia and their respective
23 officers, agents, servants, employees, and all persons in active concert or
24 participation with Defendants who receive actual notice of this order by personal
25 service or otherwise, are hereby ordered to remove and destroy all promotional
26 literature, advertising, goods and other materials relating to the use of the term
27 SAMURAY or EL ROMANTICO SAMURAY on or in connection with such
28 advertising, goods or other materials within seven (7) days following receipt of such

1 actual notice of this order, and to provide plaintiff's counsel with evidence of such
2 removal and destruction within the same seven (7) day period following receipt of
3 such actual notice.

4 5. Violation of the permanent injunction herein by any person enjoined
5 herein shall constitute contempt of court, and plaintiffs may seek to recover
6 reasonable attorney's fees and costs expended in bringing a contempt motion.

7 IV. FEES, COSTS AND RETENTION OF JURISDICITON

8 6. The Court declines to award attorney's fees to Plaintiffs.

9 7. Plaintiff is awarded costs of suit in an amount to be determined by the
10 Clerk of the Court.

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13 9. Plaintiff is hereby authorized to engage in post-judgment discovery as
14 necessary to ensure compliance with the Court's Judgment and Permanent
15 Injunction.

16 IT IS SO ORDERED.

17
18 Dated: October 01, 2015



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20 HON. DEAN D. PREGERSON
21 UNITED STATES DISTRICT JUDGE
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CERTIFICATE OF SERVICE

I hereby certify that the foregoing document is being served on respondent Favian Tapia Matilde and on applicants Favian Tapia and Delia Tapia by U.S. Mail deposited today's date, addressed as follows:

Favian Tapia Matilde
Delia Tapia
1441 S. Hope Street
Apt 218
Los Angeles, CA 90015

Dated: October 18, 2016

/stevenjeyre/
Steven J. Eyre